

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

The specification has been amended to correct matters of form and one or more typographical errors. It is respectfully submitted that no new matter has been introduced.

Claim 32 was amended solely for addressing an informality, and thus, not for reasons related to patentability. The scope of claim 32 remains unchanged. Claims 32, 34, 35, and 37 are now pending in this application. Claim 32 is the independent claim.

I. The Anticipation Rejection

Claims 32, 34, 35, and 37 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Han (U.S. Patent No. 6,009,097) was cited. This rejection is respectfully traversed.

Han fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, ____ (Fed. Cir. Jan. 6, 2003) (“A claimed invention

cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

Moreover, Han fails to properly establish inherent anticipation. See MPEP 2112. “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). No evidence has been presented that admittedly the “missing descriptive material is ‘necessarily present’” in Han.

Specifically, claim 32 recites a “fast packet switch including address translation circuitry for **translating** user data within at least one of the **frame relay data packets** into a fast packet address”.

Han allegedly recites that “[t]he system of the invention **uses ATM switches** as high performance Internet routers by using standard ATM signaling to set up cut-through paths.” See Abstract. “To explain the operation of the system”, Han makes “specific reference ... to FIG. 1. FIG. 1 shows a network consisting of a first host terminal (HT) 2 and a second host terminal (HT) 4. Host terminals 2 and 4 can consist of a personal computer, mainframe computer or any other device capable of sending and receiving data packets **using ATM**.” See col. 2, lines 54-59.

Han does not teach expressly or inherently “frame relay data packets”. Moreover, Han does not teach expressly or inherently that “ATM” is synonymous with “frame relay”. Further, Han does not teach expressly or inherently that “ATM switches” can “translat[e] user data within... frame relay data packets”.

Accordingly, it is respectfully submitted that the rejection of claims 32 is unsupported by Han and should be withdrawn. Also, the rejection of claims 34, 35, and 37, each ultimately depending from one of independent claim 32, is unsupported by Han and also should be withdrawn.

CONCLUSION

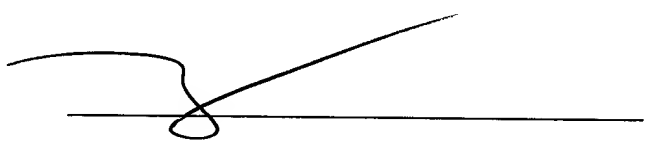
It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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